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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,216	07/02/2001	Jennifer L. Hillman	PF-0181-2 CON	3495
27904	7590	02/18/2004	EXAMINER	
INCYTE CORPORATION 3160 PORTER DRIVE PALO ALTO, CA 94304			YAEN, CHRISTOPHER H	
			ART UNIT	PAPER NUMBER

1642

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/898,216

**Applicant(s)**

HILLMAN ET AL.

**Examiner**

Christopher H Yaen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-18,20-23,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 3,6-16,20-23,28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2003 has been entered.
2. Accordingly, claims 4-5, 19, 21-22, 24-27 and 30-45 are canceled without prejudice or disclaimer.
3. Claims 1-3, 6-18, 20-, 23, and 28-29 are pending, claims 3, 6-16, 20-23, and 28-29 are withdrawn from further consideration as being drawn to non-elected invention(s).
4. Claims 1, 2, 17, and 18 are examined on the merits.

### ***Claim Rejections Maintained - 35 USC § 101***

5. It is noted that the applicant's arguments are identical to those filed 5/9/2003. Because no additional arguments have been presented, the rejection is maintained for the reasons of record, which are reiterated and represented below.
6. The rejection of claims 1-2, and 17-18 under 35 USC 101 as lacking a specific or well established utility is maintained for the reasons of record. Applicant argues that the rejection is improper because the claimed invention has patentable utility based on the following reasons:

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- the instantly claimed protein is useful for toxicology testing, drug development, and the diagnosis of disease, and
- the claimed protein is a member of the integral membrane protein family and because it is a member of said family, it alone demonstrates useful utility.

Applicant further submits a declaration of Lars Michael Furness to further substantiate the practical uses of the instant invention (gene protein expression monitoring (2D gels and western blotting)). Further still, applicant argues that law does not require knowledge of biological function to prove utility. Applicant's arguments are not found persuasive for the following reasons. Applicant's arguments have been carefully considered but are not found persuasive.

The assertion that the disclosed HSEBPs have biological activities similar to known human selenium-binding proteins is not credible in the absence of supporting evidence, because the relevant literature reports numerous examples of polypeptide families wherein individual members have distinct, and even opposite, biological activities. For example, Tischer et al. (U.S. Patent 5,194,596) establishes that VEGF (a member of the PDGF, or platelet-derived growth factor, family) is mitogenic for vascular endothelial cells but not for vascular smooth muscle cells, which is opposite to the mitogenic activity of naturally occurring PDGF which is mitogenic for vascular smooth muscle cells but not for vascular endothelial cells (column 2, line 46 to column 3, line 2). The differences between PDGF and VEGF are also seen *in vivo*, wherein endothelial-pericyte associations in the eye are disrupted by intraocular administration of PDGF but accelerated by intraocular administration of VEGF (Benjamin et al., 1998, Development 125:1591-1598; see Abstract and pp. 1594-1596). Vukicevic et al. (1996, PNAS USA

93:9021-9026) disclose that OP-1, a member of the TGF- $\beta$  family of proteins, has the ability to induce metanephrogenesis, whereas closely related TGF- $\beta$  family members BMP-2 and TGF- $\beta$ 1 had no effect on metanephrogenesis under identical conditions (p. 9023, paragraph bridging columns 1-2). See also Massague, who reviews other members of the TGF- $\beta$  family (1987, Cell 49:437-8, esp. p. 438, column 1, second full paragraph to the end). Similarly, PTH and PTHrP are two structurally closely related proteins which can have opposite effects on bone resorption (Pilbeam et al., 1993, Bone 14:717-720; see p. 717, second paragraph of Introduction). Finally, Kopchick et al. (U.S. Patent 5,350,836) disclose several antagonists of vertebrate growth hormone that differ from naturally occurring growth hormone by a single amino acid (column 2, lines 37-48).

Generally, the art acknowledges that function cannot be predicted based solely on structural similarity to a protein found in the sequence databases. For example, Skolnick et al. (2000, Trends in Biotech. 18:34-39) state that knowing the protein structure by itself is insufficient to annotate a number of functional classes, and is also insufficient for annotating the specific details of protein function (see Box 2, p. 36). Similarly, Bork (2000, Genome Research 10:398-400) states that the error rate of functional annotations in the sequence database is considerable, making it even more difficult to infer correct function from a structural comparison of a new sequence with a sequence database (see especially p. 399). Such concerns are also echoed by Doerks et al. (1998, Trends in Genetics 14:248-250) who state that (1) functional information is only partially annotated in the database, ignoring multi functionality, resulting in

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underpredictions of functionality of a new protein and (2) overpredictions of functionality occur because structural similarity often does not necessarily coincide with functional similarity. Smith et al. (1997, *Nature Biotechnology* 15:1222-1223) remark that there are numerous cases in which proteins having very different functions share structural similarity due to evolution from a common ancestral gene. Brenner (1999, *Trends in Genetics* 15:132-133) argues that accurate inference of function from homology must be a difficult problem since, assuming there are only about 1000 major gene superfamilies in nature, then most homologs must have different molecular and cellular functions. Bork et al. (1996, *Trends in Genetics* 12:425-427) add that the software robots that assign functions to new proteins often assign a function to a whole new protein based on structural similarity of a small domain of the new protein to a small domain of a known protein. Such questionable interpretations are written into the sequence database and are then considered facts. Finally, Bowie et al. (1990, *Science* 247:1306-1310) state that determination of three dimensional structure from primary amino acid sequence, and the subsequent inference of detailed aspects of function from structure is extremely complex and unlikely to be solved in the near future (p. 1306). Thus, the specification fails to support the asserted credible, specific and substantial utility of human synthase activity.

The specification does not support a credible, specific and substantial utility regarding the claimed polypeptide and fragments/variants thereof for purposes unrelated to the asserted biological activity. For example, the specification asserts that the claimed polypeptide plays a role ion channel regulation based solely on the

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structural similarity to stomatin. The specification does not disclose a correlation between any specific disorder and an altered level or form of the claimed polypeptide. Also, the specification does not predict whether the claimed polypeptide would be overexpressed or underexpressed in a specific, diseased tissue compared to the healthy tissue control. The specification contains assertions that the claimed polypeptide can be used gene expression monitoring assays, which are used in the art for drug development and toxicology studies. However, without a disclosure of a particular disease state in which the claimed polypeptides are expressed at an altered level or form, it would be impossible to determine what the results of a gene expression monitoring assay mean.

Applicant presents the Furness Declaration as direct proof of the utility of the instant invention that "direct proof" (referring to the Furness Declaration) of the utility of the claimed invention was submitted May 9, 2003 (paper no. 13). A specification can meet the legal requirements of utility and enablement for a new polypeptide as long as the specification discloses a credible, specific and substantial asserted utility for the new polypeptide or a well-established utility for the claimed polypeptide. A hypothetical example may serve to clarify. For example, a hypothetical specification discloses that a claimed polypeptide is expressed in colon cancer and not expressed in healthy colon tissue. The hypothetical specification does not disclose the biological activity of the claimed polypeptide. The claimed polypeptide in the hypothetical example would not be rejected under 35 USC 101 and 112, first paragraph, as it has utility and is enabled as a colon cancer marker. However, such is not the fact pattern here. The instant

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specification discloses that the claimed polypeptides are structurally related to stomatin or has ion channel regulating properties, but the expression of the claimed polypeptides in diseased tissues and the corresponding healthy tissues was not evaluated.

Therefore, there is no disclosure that the claimed polypeptides are expressed at altered levels or forms in any specific, diseased tissue. It is noted that the instant application was filed March 16, 2000. No evidence has been brought forth during the prosecution history regarding the expression levels in diseased or healthy tissue. Also no evidence has been brought forth that the claimed polypeptides are in fact ion channel regulators.

The instant application has failed to provide guidance as to how one of skill in the art could use the claimed invention in a way that constitutes a credible, specific and substantial utility. The proposed uses of the claimed invention are simply starting points for further research and investigation into potential practical uses of the claimed nucleic acids. "Congress intended that no patent be granted on a chemical compound whose sole 'utility' consists of its potential role as an object of use-testing." *Brenner v. Manson*, 148 USPQ at 696.

Claims 1,2,17 and 18 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by a well established utility for the reasons set forth in the rejection under 35 USC 101 above, one skilled in the art clearly would not know how to use the claimed invention for practical benefits.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***



7. It is noted that the applicant's arguments are identical to those filed 5/9/2003.

Because no additional arguments have been presented, the rejection is maintained for the reasons of record, which are reiterated and represented below.

8. The rejection of claims 1-2 and 17-18 under 35 USC§112, 1<sup>st</sup> paragraph as lacking proper written description is maintained for the reasons of record. Applicant's arguments have been carefully considered but are not found persuasive for the following reasons. Applicant argues that SEQ ID No: 1 is fully disclosed in the specification and one of skill in the art would clearly understand a molecule having 90% identify, a biologically active fragment of SEQ ID No: 1, and an immunogenic fragment of SEQ ID No: 1. Although the examiner does not contend that this is true, in order to have proper written description of a sequence, the amino acid sequence itself is required (see *Fiers v. Revel*, 25 USPQ 2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Lts.*, 18 USPQ2d 1016.). Regarding immunologically active fragments, because the fragments themselves are not disclosed, one of skill in the arts would not understand how to or what to screen. Potentially, the entire protein could be immunogenic given that enough of the protein fragments are administered to elicit a response. And lastly, one of skill in the art would be required to screen numerous parts of the protein to look for active fragments, because as disclosed in the specification, there are numerous motifs localized within the protein sequence. Because the mere recitation of the fragments does not qualify as adequate written description, one of skill would not know where to begin to search for such active fragments. The essential structural feature that provides the recited function of variants

or biologically active fragments of an IMP protein have not been taught. The Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement make clear that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 3<sup>rd</sup> column).

Applicant has not reduced to practice any variants or fragments of IMP. Neither has Applicant provided a sufficient written description of any structure that may be correlated with the desired function of ion channel regulation.

9. It is further noted that applicant responds to both 102(b) and (e) rejections is considered moot in view of the withdrawal of the rejections made in a paper mailed 8/01/2003.

### ***Conclusion***

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

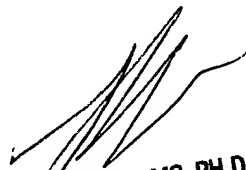
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen  
Art Unit 1642  
February 5, 2004



LARRY R. HELMS, PH.D  
PRIMARY EXAMINER